REMARKS

Claims 80, 85 and 88 are independent and stand rejected under 35 U.S.C. § 102 as being anticipated by Killian et al. '992 ("Killian") and Boutaud et al. '418 ("Boutaud"). These rejections are respectfully traversed for the following reasons.

In order to expedite prosecution, a personal interview was conducted with Examiner Coulter. Applicant and Applicant's representative would like to thank Examiner Coulter for his courtesy in conducting the interview and for his assistance in resolving issues. As a result of the interview, it was agreed that the enclosed amendment obviates the pending rejections and would place the application in condition for allowance pending an updated prior art search. A summary of the interview discussion follows.

Claim 80 recites in pertinent part, an "instruction [which] designates a first register or a second register ... [and] a first unit configured to perform sign-extending of the certain data if the instruction designates the second register; and a second unit configured to perform zero-extending of the certain data if the instruction designates the first register." Claims 85 and 88 recite similar features. Accordingly, which operation is performed (sign-extending or zero-extending) is dependent on which *register* is designated in the instruction.

In contrast, in Killian, an instruction designates two registers rather than designate a register between two registers (col. 7, line 67), and the operation to be performed (sign-extending or zero extending) is dependent on which *instruction*. For example, as discussed during the interview, a load/store instruction would effect a sign-extending operation (col. 7, line 68 – col. 8, line 3 of Killian), etc..

Boutaud, on the other hand, expressly discloses at col. 6, lines 2-6 that the "LSBs (least significant bits) of the output are filled with zeros, and the MSBs (most significant bits) may be

4

either filled with zeros or sign-extended, ***depending upon the state of the sign-extension mode bit SXM of the status register STI***" (emphasis added). Accordingly, the operation to be performed is dependent on the state of a bit within a given register, rather than on which of a first or second register is designated.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that the cited prior art does not anticipate the independent claims, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.,* 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102 be withdrawn.
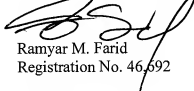
CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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